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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of  
Myron L. Munn

Serial No.: 10/829,005

Filed: April 21, 2004

Title: OIL FILTER ADAPTER

Group No.: 1723

BEFORE THE BOARD  
OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. \_\_\_\_\_

APPELLANT'S APPEAL BRIEF

Commissioner for Patents  
Alexandria, VA 22313

Dear Sir:

REAL PARTY IN INTEREST

The Appellant, Myron L. Munn, has not assigned any of his rights to the invention; therefore, the real party in interest is Myron L. Munn.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF THE CLAIMS

Claims 1-3 and 5 have been cancelled. Claims 4 and 6-8 have received a final rejection and this appeal is an appeal of the final rejection of claims 4 and 6-8.

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1 side thereof which is adapted to threadably receive the externally threaded filtered oil  
tube 12 of the oil filter receptacle 10. (Page 6, lines 15-25; page 7, lines 1-3). Claim  
4 specifically describes that the disc-shaped adapter member 28 has an externally  
threaded, hollow nipple 50 extending from its filter side at the center thereof which is  
5 in communication with the interior of the internally threaded central opening 40 in the  
disc-shaped adapter member 28. (Page 7, lines 4-7). Claim describes that the  
threads of the hollow nipple 50 match the threads of the oil outlet 52 of the  
replacement oil filter canister 24. (Page 6, lines 24, 25; page 7, lines 1, 4-10). Claim  
10 4 further describes that the disc-shaped adapter member 28 has a plurality of  
spaced-apart unfiltered oil passageways 54 formed therein which extend  
therethrough from the engine side to the filter side thereof outwardly of the central  
opening of the disc-shaped adapter member 28. (Page 7, lines 23-25; page 8, lines  
1-4).

15 Claim 4 also describes that the filter side of the disc-shaped adapter member  
28 has an annular seat 46 formed thereon which is positioned outwardly of the hollow  
nipple 50 and the unfiltered oil passageway 54 thereof. (Page 7, lines 4-6). Claim 4  
describes that the internally threaded filtered oil outlet 52 of the replacement oil filter  
20 canister 24 selectively threadably receives the externally threaded hollow nipple 50  
whereby the canister O-ring or gasket 26 of the replacement oil filter canister 24 may  
be drawn into sealing engagement with the annular seat 46 on the filter side of the  
disc-shaped adapter member 28. (Page 7, lines 11-25; page 8, lines 1-20).

1           Claim 6 depends from claim 4 and specifically describes that the threads of  
the internally threaded central opening 40 of the disc-shaped adapter member 28 are  
SAE threads and the threads of the hollow nipple 50 are metric threads. (Page 6,  
lines 24, 25; page 7, lines 9, 10).

5           Claim 7 depends from claim 4 and describes that the annular seat 46 on the  
filter side of the disc-shaped adapter member 28 has a width sufficiently large  
enough to enable replacement oil filter canister O-rings or gaskets of various  
diameters to be placed into sealing engagement therewith. (Page 8, lines 22-25;  
10 page 9, lines 1-8).

          Claim 8 is dependent on claim 4 and describes that the disc-shaped adapter  
member 28 and the hollow nipple 50 are of one-piece construction. (Page 6, lines 6,  
7; Fig. 5).

15           Each of the claims 4, 6, 7 and 8 are believed to be independently patentable  
and stand by themselves.

          GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL          

          (A) Whether claims 4 and 7 are patentable over Sparling US 5,766,451  
pursuant to 35 U.S.C. § 102(b).

20           It is the Examiner's contention that with respect to claim 4, Sparling teaches  
an oil filter adapter comprising: a disc-shaped adapter member (10) having an  
engine side and a filter side with the engine side having an annular O-ring (36) in a  
groove (38) with the O-ring (36) having the same diameter of a standard canister O-  
25 ring. The Examiner believes that the adapter member (10) of Sparling has an

1 internally threaded central opening (20) formed therein which extends inwardly from  
the engine side thereof which is adapted to threadably receive an externally threaded  
filtered oil tube of the oil filter receptacle with the adapter member having an  
externally threaded, hollow nipple (4) extending from the filter side at the center  
5 thereof which is in communication with the interior of the internally threaded central  
opening in the adapter member. The Examiner further contends that with respect to  
claim 4, the threads of the hollow nipple match the threads of the oil outlet of the  
replacement oil filter canister (58) with the adapter member having a plurality of  
10 spaced-apart unfiltered oil passageways (17) formed therein which extend  
therethrough from the engine side to the filter side thereof outwardly of the central  
opening of the adapter member. The Examiner further contends that the filter side of  
the adapter member has an annular seat (26) formed thereon which is positioned  
outwardly of the hollow nipple and the unfiltered oil passageway thereof and that the  
15 internally threaded filtered oil outlet of the oil filter canister threadably receives the  
externally threaded hollow nipple whereby the canister O-ring may be drawn into  
sealing engagement with the annular seat of the adapter member. (Fig 3).

20 With respect to claim 7, the Examiner contends that Sparling further teaches  
that the threads of the internally threaded central opening of the adapter member are  
different than the threads on the hollow nipple and refers to Col. 7, lines 53-59. The  
Examiner also believes that the annular seat on the filter side of the adapter member  
of Sparling has a width sufficiently large enough to enable replacement oil filter  
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1 canister O-rings of various diameters to be placed into sealing engagement therewith  
and refers to Fig. 3.

(B) Whether claim 6 is anticipated by or, in the alternative, under 35 U.S.C.  
§ 103(a) as being obvious over Sparling '451.

5 In paragraph No. 3 of the final rejection, the Examiner rejected claim 7, but it is  
assumed that "7" was a typographical error and that the rejection should have been  
directed to claim 6. In the rejection, the Examiner contends that Sparling teaches  
that the threads of the internally threaded central opening of the Sparling adapter  
10 member are different than the threads of the hollow nipple (Col. 7, lines 53-59), but  
admits that Sparling is silent about the internally threaded opening threads being  
SAE threads and that the hollow nipple threads are metric threads. The Examiner  
concluded that having different configurations of a filter and its connections would  
imply such a configuration as taught by Sparling (Col. 7, lines 53-59) or in the  
15 alternative would have been obvious to one of ordinary skill in the art at the time the  
invention was made because the use of metric and SAE threads are commonplace in  
engine connections and oil filters.

(C) Whether claim 8 is patentable over Sparling '451 under 35 U.S.C. §  
20 103(a).

The Examiner states that Sparling teaches the adapter member of claim 4, but  
admits that Sparling does not teach a one-piece construction. The Examiner  
concluded that it would have been obvious to one of ordinary skill in the art at the  
25 time the invention was made to make the adapter member and the hollow nipple a

1 one-piece construction on the grounds that the use of a one-piece construction ...  
would be merely a matter of obvious engineering choice and cites In re Larson, 144  
USPQ 347, 349 (1965).

### 5 ARGUMENT

(A) Whether claims 4 and 7 are patentable over Sparling US 5,766,451  
pursuant to 35 U.S.C. § 102(b).

Sparling relates to an inline pressure oil filter adapter which places an anti-  
siphon or anti-drain back valve into the stream of lubricant pumped to lubricate the  
10 engine or mechanical device to keep the lubricant out of the lubrication system and  
oil filter once the lubrication pump providing the stream of lubricant is turned off. The  
fluid filter adapter of Sparling does not enable a replacement oil filter canister to be  
substituted for the standard oil filter canister as required by claims 4 and 7. Claim 4  
specifically describes that the replacement oil filter canister has a length greater than  
15 the standard oil filter canister and has an O-ring or gasket provided thereon which  
has a greater diameter than the standard canister O-ring or gasket. It is the annular  
seat 46 provided at the filter side of the adapter which enables the larger diameter O-  
ring or gasket of the replacement oil filter to sealably engage the same. As seen in  
20 Fig. 3 of Sparling, the O-ring or gasket 36 on the engine side of the adapter has the  
same diameter as the element 26. Thus, Sparling cannot anticipate claims 4 and 7.  
Claim 7 depends from claim 4 and describes that the annular seat on the filter side of  
the disc-shaped adapter member has a width sufficiently large enough to enable  
25 replacement oil filter canister O-rings or gaskets of various diameters to be placed

1 into sealing engagement therewith. There is absolutely no teaching whatsoever in Sparling that the Sparling adapter enables replacement oil filter canister O-rings or gaskets of various diameters to be placed into sealing engagement with the claimed annular seat which is on the filter side of the disc-shaped adapter member.

5 Accordingly, it is believed that each of claims 4 and 7 are independently patentable and stand by themselves.

(B) Whether claim 6 is anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Sparling '451.

10 Claim 6 depends from claim 4 and specifically describes that the threads of the internally threaded central opening of the disc-shaped adapter member are SAE threads and the threads of the hollow nipple are metric threads. With respect to the Examiner's contention that Sparling teaches the threads of the internally threaded central opening of the adapter member to be different than the threads on the hollow nipple, Appellant submits that there is no suggestion or inherent teaching in Sparling that the threads of the internally threaded opening of the disc-shaped member could be SAE threads and that the threads of the hollow nipple could be metric threads. 15 Accordingly, claim 6 cannot be anticipated. With respect to the Examiner's alternative rejection under 35 U.S.C. § 103(a), there is absolutely no suggestion, teaching or motivation in Sparling to modify Sparling to provide the claimed SAE threads and metric threads. It is quite apparent from the prior art that Appellant is the first person to provide the claimed adapter wherein the threads of the internally threaded central opening of the disc-shaped adapter member are SAE threads and 20 25

1 the threads of the hollow nipple are metric threads. This structure enables the larger  
capacity replacement oil filter canister, which has internal metric threads, to be  
utilized with an oil filter receptacle of an automotive engine which has an externally  
threaded filtered oil tube which has SAE threads. Appellant submits that claim 6 is  
5 not anticipated by Sparling nor is it made obvious by Sparling.

(C) Whether claim 8 is patentable over Sparling '451 under 35 U.S.C. §  
103(a).

Claim 8 depends from claim 4 and that the disc-shaped adapter member and  
10 the hollow nipple are of one-piece construction. Claim 8 is believed to be allowable  
for the reasons expressed in support of claim 4 and is believed to be independently  
patentable and stands by itself. The one-piece construction of Appellant's adapter  
enables the larger replacement oil filter canister to be mounted to the oil filter  
receptacle of an automotive engine in a very quick and convenient fashion. The fact  
15 that Appellant's adapter is of one-piece construction eliminates any possibility of  
leakage between the nipple and the remaining structure as may be possible in the  
Sparling structure. Accordingly, it is believed that claim 8 is clearly patentable over  
Sparling.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that the original of APPELLANT'S APPEAL BRIEF for MYRON L. MUNN, Serial No. 10/829,005, was mailed by first class mail, postage prepaid, to the Mail Stop Appeal Briefs-Patent, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8th day of March, 2007.



DENNIS L. THOMTE

## CLAIMS APPENDIX

1. (Cancelled)

2. (Cancelled)

3. (Cancelled)

4. (Appealed) An oil filter adapter for attachment to the externally threaded filtered oil tube extending outwardly from an oil filter receptacle of an automotive engine which normally threadably receives the internally threaded filtered oil outlet at one end of a standard oil filter canister with the one end thereof having a canister O-ring or gasket provided thereon, the adapter enabling a replacement oil filter canister to be substituted for the standard oil filter canister with one end of the replacement oil filter canister having a canister O-ring or gasket provided thereon outwardly of an internally threaded filtered oil outlet, the standard and replacement oil filter canisters having substantially the same diameter with the replacement oil filter canister having a greater length than the standard oil filter canister to provide a greater filter capacity thereof, the replacement canister O-ring or gasket having a greater diameter than the standard canister O-ring or gasket, the oil filter adapter comprising:  
a disc-shaped adapter member having an engine side and a filter side;  
said engine side of said disc-shaped adapter member having an annular O-ring or gasket groove formed therein;  
an O-ring or gasket positioned in said O-ring or gasket groove of said disc-shaped adapter member which is adapted to sealably engage the oil filter receptacle;

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said O-ring or gasket positioned in said O-ring or gasket groove of said disc-shaped adapter member having the same diameter as said standard canister O-ring or gasket;

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said disc-shaped adapter member having an internally threaded central opening formed therein which extends inwardly from said engine side thereof which is adapted to threadably receive the externally threaded filtered oil tube of the oil filter receptacle;

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said disc-shaped adapter member having an externally threaded, hollow nipple extending from its said filter side at the center thereof which is in communication with the interior of said internally threaded central opening in said disc-shaped adapter member;

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the threads of said hollow nipple matching the threads of the oil outlet of the replacement oil filter canister;

said disc-shaped adapter member having a plurality of spaced-apart unfiltered oil passageways formed therein which extend therethrough from said engine side to said filter side thereof outwardly of said central opening of said disc-shaped adapter member;

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said filter side of said disc-shaped adapter member having an annular seat formed thereon which is positioned outwardly of said hollow nipple and said unfiltered oil passageway thereof;

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the internally threaded filtered oil outlet of the replacement oil filter canister selectively threadably receiving said externally threaded hollow nipple

1           whereby the canister O-ring or gasket of the replacement oil filter canister may  
be drawn into sealing engagement with said annular seat on said filter side of  
said disc-shaped adapter member.

5           5. (Cancelled)

6. (Appealed) The oil filter adapter of claim 4 wherein the threads of said  
internally threaded central opening of said disc-shaped adapter member are SAE  
threads and the threads of said hollow nipple are metric threads.

10           7. (Appealed) The oil filter adapter of claim 4 wherein said annular seat on  
said filter side of said disc-shaped adapter member has a width sufficiently large  
enough to enable replacement oil filter canister O-rings or gaskets of various  
diameters to be placed into sealing engagement therewith.

15           8. (Appealed) The oil filter adapter of claim 4 wherein said disc-shaped  
adapter member and said hollow nipple are of one-piece construction.

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.